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IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, [redacted] / 950

No. [redacted]
32

THE GREAT ATLANTIC & PACIFIC TEA COMPANY,
Petitioner,

vs.

SUPERMARKET EQUIPMENT CORPORATION,
Substituted for EVELYN B. BRADLEY
and JOE WEINGARTEN,
Respondent.

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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IN THE

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No. 686

THE GREAT ATLANTIC & PACIFIC TEA COMPANY,
Petitioner,

vs.

SUPERMARKET EQUIPMENT CORPORATION,
Substituted for EVELYN B. BRADLEY and JOE WEINGARTEN,
Respondent.

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

STATEMENT

Owing to Petitioner's failure to perceive the invention involved in the present litigation, and owing to various errors in the petition and the supporting brief, Respondent finds it necessary to comment thereon.

Petitioner has formally invoked the jurisdiction of this court, and presented various statutes which are alleged to be involved herein, Respondent denies that the disclaimer statute is in any manner involved herein, and likewise wishes to point out that the quotation on

page 3 of the petition, purporting to be from R.S. 4917 contains language which is not found in that statute. Rather, the last five lines of the portion quoted are found in R. S. 4922. This statute is, likewise, not pertinent to the present litigation.

The Stipulation of Infringement Left Only the Issue of Validity which Both Lower Courts Decided in Favor of Respondent.

Prior to the trial of this cause the parties thereto, through counsel, stipulated to the effect that, if valid, claims 4, 5 and 6 of Turnham Patent No. 2,242,408 were infringed by equipment then in use by Petitioner. Petitioner, at pages 3 and 7, and in other places in the petition and brief, alleges that the charge of infringement is based on the use of a three-sided bottomless rack on a checkout counter. At no point in these allegations does Petitioner state that the three-sided bottomless rack in use is employed in combination with a counter having an extension or elongation thereon to locate the cash register and cashier's position intermediate the ends thereof, rather than adjacent one end, as was the practice prior to the invention of the patent in suit.

The Turnham Patent, No. 2,242,408, discloses and claims a combination employed as a checker's stand or cashier's counter and particularly adapted for use in self-service grocery stores, the counter being formed with an extension which functions to relocate the cash register, as described above, together with a three-sided bottomless frame and guide means cooperating therewith mounted upon the extended portion of the checker's stand for cooperation therewith in the movement of groceries. Turnham's contribution to the self-serve food retailing industry took substance in an elongation

of the existing counter in a direction behind the cash register, and the use therewith of a guided bottomless self-unloading frame adaptable to move groceries placed on the extended portion from the position of placement to a point adjacent the cashier's position where the groceries could be sorted and the charge therefore entered on a totalizing cash register.

The District Court, in an exhaustive opinion (R. 564) analyzed the defenses presented there by Petitioner and concluded that the three claims upon which Respondent chose to rely were valid and infringed. The separately filed findings of fact and conclusions of law (R. 577) clearly indicate the type of consideration given the claims in evidence, by the District Court.

The Court of Appeals for the Sixth Circuit, in its opinion, (R. 591) reanalyzed the existence of the problem, the contribution of Turnham, and the claims in suit, and, giving effect to Rule 52(a) F.R.C.P., concluded that the District Court was supported in all of its findings and that there was no ground for reversal. Judge Martin dissented, principally on the language of *Cuno Engineering Corp. vs. Automatic Devices Corp.*, 314 U.S. 84.

Does this Case Present Any Issue which ought to be Decited by this Court?

The above question must be answered in the negative, for the ordinary patent infringement case presents no problem worthy of consideration by this Court:

Layne & Bowler Corp. vs. Western Well Works, Inc., 261 U. S. 387, 388, 393;

Keller vs. Adams-Campbell Co., 264 U. S. 314, 319;

General Talking Pictures Corp. vs. Western

On October 11, 1948, this Court granted a petition for a writ of certiorari and later heard argument and decided *Graver Tank and Mfg. Co., Inc., et al vs. Linde Air Products Co.*, 336 U. S. 271. In that case, at page 275, there appears:

> "A court of law, such as this Court is, rather than a court for the correction of errors in fact finding, cannot undertake to review concurrent findings of fact by two courts below in the absence of a very obvious and exceptional showing of error." (Citing cases).

On March 28, 1949, this Court granted a petition for a writ of certiorari and later decided *Faulkner vs. Gibbs*, 338 U. S. 267, 70 S. Ct. 25. In that case at 338 U.S. 268, we find:

> "We will not disturb the concurrent findings upon the issues presented to us in the petition for certiorari. We are not persuaded that the findings are shown to be clearly erroneous."

The present case clearly falls within the plain language of these very late decisions.

Summary of Argument

1. Petitioner has failed to show how the admittedly infringed claims in issue do not completely conform to the statutory requirements of distinctly setting forth the novel combination invented by Turnham.

2. The concurrent findings and conclusions of the two lower courts conform completely to the decisions of this Court defining the test of invention.

3. Respondent's reliance on the three narrower claims of the patent and the refusal of the two lower courts to pass on the validity of the broader claims is

not at variance with the statutes or with the decisions of this Court.

ARGUMENT

1. Petitioner has failed to show how the admittedly infringed claims in issue do not completely conform to the statutory requirements of distinctly setting forth the novel combination invented by Turnham.

Petitioner seeks to destroy the claims which two courts have found valid and infringed by claiming that an element necessary to the validity of these claims is not present in them. It is submitted that Turnham's invention took substance in an altered form of check-out counter upon which a guided bottomless pusher is mounted. The claims in issue clearly point out the combination contributed by Turnham.

As in all patents, the claims are addressed to persons skilled in the art to which the patent in question appertains. The claims in the Turnham patent are not addressed to manufacturers of automobiles, chemists, or even lawyers, but are addressed to the operators of self-service grocery stores and those individuals building equipment for use in such establishments. The claims in suit, as required by the statutes and the decisions, clearly delineate the scope of Turnham's monopoly, when considered by those persons to whom they are addressed.

The L-shaped counter was in common use in self-service grocery stores at the time Turnham entered the field with his invention. The L-shaped counter was, at that time, usually constructed with a small wing immediately adjacent the extreme end of the counter, upon which wing the cash register was positioned. Turnham added structure to the well-known L-shaped counter,

which additions changed its form and increased its efficiency vastly.

Petitioner questions the inclusion of the entire patented combination in claim 4 which reads as follows:

> "4. A checker's stand including A COUNTER OF THE CHARACTER DESCRIBED, an open bottom pusher frame thereon, means to guide said frame in sliding movement so that goods placed ON THE END of said counter within said frame may be pushed along the counter in a group to a position adjacent the checker by movement of said frame." (Emphasis added).

The question immediately arises: What is "a counter of the character described"? Referring to the specification (R. 371) on page 1 of the patent, right hand column, line 21, we find:

> "In Fig. 2 the cashier or checker's counter is indicated generally at 2 and as seen in Fig. 2 is an *elongated* counter having a top 3 thereon." (Emphasis added).

At line 48 there appears:

> "The present invention contemplates the provision of an *extension* on the counter such as seen at 15 in Fig. 1. This *extension* may be of the same width as the top 3 of the counter 2 and may be of any desired length. This *extension* 15 is provided with top 16 *upon which the various articles 17 are deposited* either by the customer or by what will be known hereinafter as the pusher boy." (Emphasis added).

Petitioner has, likewise, attacked claim 5 on the same ground, which claim reads as follows:

> "5. A cashier's counter for cash and carry type of grocery comprising A PORTION SPACED

FROM THE CASHIER'S STAND AND UPON WHICH THE MERCHANDISE MAY BE DEPOSITED AND ARRANGED, a bottomless three sided frame on SAID PORTION and within which the merchandise is deposited and arranged, means whereby said frame is moveable on said counter from SAID PORTION to a position adjacent the cashier's stand so that the merchandise may thus be moved as a group to a point where it may be conveniently observed, counted and registered by the cashier." (Emphasis added).

Claim 6 is, likewise, under similar attack:

"6. A cashier's counter for cash and carry type of grocery comprising A PORTION SPACED FROM THE CASHIER'S STAND AND UPON WHICH THE MERCHANDISE MAY BE DEPOSITED AND ARRANGED, a bottomless frame on SAID PORTION and within which the merchandise is deposited and arranged, means whereby said frame is moveable on said counter from SAID PORTION to a position adjacent the cashier's stand so that the merchandise may thus be moved as a group to a point where it may be conveniently observed, counted and registered by the cashier, said frame being open at the end adjacent the cashier's stand and readily moveable to be returned over SAID PORTION so as to receive the merchandise of another customer while the cashier is occupied with the previous group." (Emphasis added).

These claims are prima facie proof that the Petitioner's position is not founded in fact, for the "extension" is positively included in each of them. P. Ex. 25 (R. 207, 428) compares claim 6 to the structure used by defendant and illustrates the manner in which the extension portion is positively included.

It is submitted that claims 4, 5 and 6 of the Turnham patent each describe various elements cooperating to form the combination of the patent, and that, therefore, the two lower courts did not read in a feature not present in order to sustain the validity of the three claims. Petitioner cites *McCarty vs. Railroad Co.*, (160 U. S. 110, 116) in support of its position but it is submitted that the case is not in point here. These two claims, each of which described a truck bolster for use on a railroad car, had been found invalid by a trial court because of anticipation. In those two claims the bolster was described as comprising various bars and plates. The patentee wished to include a spring shown in the prior art and upon which the end of the bolster rested, but this Court refused the inclusion since there was absolutely no suggestion of a spring in the two claims. This is certainly different from the situation here, where the particular counter structure is specifically pointed out in each of the claims, as concurrently found by two courts below.

Petitioner quotes from *Altoona Publix Theatres, Inc. vs. American Tri-Ergon Corp.*, 294 U. S. 477. This case, likewise, is not in point, for there the owner of the patent wished to add the location of a flywheel in order to validate the claim in issue. As in the *McCarty* case, the adding of the location of the flywheel would not validate the claim because the feature was within the teaching of the prior art. This case has no bearing on the present situation, and is considered distinguished.

It is submitted that the case law cited has nothing to do with the present litigation. The claims here are directed to a new combination of elements which are distinctly pointed out in each of the three claims in issue. The situation is very similar to the recently de-

cided case of *Faulkner vs. Gibbs*, 338 U. S. 267, where we find, at 268:

> "In the instant case, the patent has been sustained because of the fact of combination rather than the novelty of any particular element."

2. The concurrent findings and conclusions of the two lower Courts conform completely to the decisions of this Court defining the test of invention.

Petitioner, by the attack embodied in the second portion of its argument, seeks to have this Court review the concurrent findings of the two lower courts. The Court of Appeals, in deciding this case, accepted the uncontroverted facts as found by the District Court, which facts led only to the conclusion that the Turnham patent satisfied all tests of invention as laid down by this Court. That this court does not lightly indulge in the review of concurrent findings is supported by the following cases:

General Talking Pictures Corp. vs. Western Electric Co., 304 U. S. 175, 178;
Williams Manufacturing Co. vs. U. S. Shoe Machinery Corp., 316 U. S. 364, 367;
Goodyear Tire & Rubber Co., Inc. et al vs. Ray-O-Vac Co., 321 U. S. 275, 278;
Graver Tank & Mfg. Co., Inc., et al vs. Linde Air Products Co., 336 U. S. 271;
Faulkner vs. Gibbs, 338 U. S. 267, 268.

It is, likewise, submitted that the invention of Turnham satisfies all of the tests of invention laid down by this Court, and that there is, therefore, no reason to conclude that the concurrent findings of the lower courts

should be overthrown. An analysis of Turnham's contribution clearly indicates that it rises to the level of invention as defined in *Cuno Engineering vs. Automatic Devices Corp.*, (314 U. S. 84); *Williams Mfg. Co. vs. U. S. Shoe Machinery Co.*, 316 U. S. 364; *Goodyear Tire & Rubber Co. Inc., et al vs. Ray-O-Vac Co.*, 321 U. S. 275; *Jungerson vs. Ostby*, 335 U. S. 560; and *Faulkner vs. Gibbs*, 338 U. S. 267.

Turnham's contribution to the self-serve grocery industry was a combination which, by the uncontroverted evidence before both of the courts below, increases the efficiency of the check-out counter by over 30% (R. 83). The District Court so stated its opinion (R. 573) and in finding of fact No. 14 (R. 579). The Court of Appeals concurred in these findings in its opinion (R. 594).

The record is replete with evidence as to the wide use and acceptance of the patented device, with a complete absence of sales promotion and advertising.

Goodyear vs. Ray-O-Vac, 321 U. S. 275 is particularly in point in this consideration. In that case a relatively simple device (the steel jacket for a flashlight battery) had been needed for years to alleviate the problem encountered with the deterioration and subsequent swelling of these batteries in use. The introduction of the device met with widespread and immediate acceptance since it clearly satisfied a long-felt need.

Here the problem of waiting in line was born with the birth of the self-serve grocery store in 1917, and steadily grew as self-serve grocery stores became more numerous. The combination invented by Turnham increased the efficiency of the check-out counter by over 30%, thereby alleviating the waiting-in-line problem. The device was widely adopted by those to whom its advantages were immediately [illegible]

The two cases are parallel in all respects, even to the fact that the District Court and the Court of Appeals in the Goodyear case also made concurrent findings which this Court refused to set aside.

3. Respondent's reliance on the three narrower claims of the patent and the refusal of the two lower Courts to pass on the validity of the broader claims is not at variance with the statutes or with the Decisions of this Court.

Prior to the trial of this case in the District Court the parties thereto, by stipulation, agreed that claims 4, 5 and 6 of the patent in suit were infringed, if valid. At the trial Respondent elected to rely on claims 4, 5 and 6 over the objection of the Petitioner and the point was considered by the District Court, as shown by the opinion (R. 576):

> "Finally, and although we deem the point immaterial, this Court holds that plaintiff has not forsaken claims 1, 2 and 3. We follow, on the contrary, the reasoning of *Ford Motor Co. v. Gordon Form Lathe Co.*, 90 F. 2d 999, to the effect that having chosen to rely upon claims 4, 5 and 6 this serves only as an amendment to the pleadings."

The Court of Appeals considered the point, it having been presented there by Petitioner, and stated (R. 597-8) as follows:

> "The District Court did not err in refusing to pass upon the validity of claims 1, 2 and 3. It was discretionary with the court whether it should permit the appellees to withdraw these claims and treat their action as an amendment to the pleadings. *Ford Motor Co. vs. Gordon Form Lathe Co.*, 90 Fed. (2d) 999 (C. A. 6). Since the District

> Court did not err in permitting the withdrawal of these claims it also did not err in allowing the costs to the appellees. Claims 1, 2 and 3 not having been found invalid, appellees were under no duty to disclaim them, and R.S. Sec. 4922, 35 U. S. C., Sec. 71, does not apply."

The point has, therefore, been thoroughly considered by both courts, and the concurrent findings of both these courts are submitted to this Court to be set aside. Respondent amended its pleadings for obvious reasons of trial convenience, and the District Court, within the discretionary powers granted by Rule 15 F.R.C.P., permitted the amendment. The ruling may be reversed only for obvious abuse of discretion, which abuse appears nowhere in the record.

The ruling of *Ford Motor Co. vs. Gordon Form Lathe Co.*, is not peculiar to the Sixth Circuit, nor is it based on any new concept developed there. Similar permissive amendments are found in the following cases:

> *Trico Products Corporation vs. The Delman Corp. et al.* (C. A. 8, Mar. 8, 1950), ... F. 2d. ....., 84 U.S.P.Q. 416;
>
> *Gamewell Fire-Alarm Telegraph Co. et al. vs. Municipal Signal Co. et al.* (C.A. 1, 1896), 77 F. 490;
>
> *Skinner Bros. Belting Co. vs. Oil Well Improvements Co.*, (C.A. 10, 1931), 54 F. 2d. 896;
>
> *Katz vs. Horni Signal Mfg. Corp.*, (D.C.S.D. N.Y., 1943) 52 F. Supp. 453;
>
> *National Electric Signaling Co. vs. DeForest Wireless Telegraph Co. et al.* (C.C.S.D.N.Y., 1905), 140 F. 449.

Petitioner cites *Ensten vs. Simon, Ascher & Co.*, 282 U. S. 445, in support of a proposition completely out of point here, for neither claim 1, 2 or 3 has been de-

cleared invalid. Likewise, in that case the court there quoted, with approval, at 282 U. S. 453, *Robinson on Patents,* (1890) Vol. II, page 284, as follows:

> "In cases where the excess is not apparent at once upon the inspection of the patent by the patentee, the allowance of his claim by the patent office raises such a presumption in its favor that he may rely on its validity until a court of competent jurisdiction decides that it is broader than his real invention."

Had Petitioner originally pleaded a declaratory judgment counterclaim requesting an adjudication of invalidity of all the claims of the patent in suit, it would have been entitled to judgment on these claims. However, since the Answer merely asks for a dismissal with costs (R. 7), there is no basis for the objection to the ruling by the District Court permitting the amendment of Respondent's pleadings.

CONCLUSION

It is respectfully submitted that Petitioner has failed to invoke the jurisdiction of this court. Petitioner has shown no conflict in decisions between the circuits, the ordinary grounds for the allowance of a writ of certiorari in patent cases. Petitioner has shown no conflict between the decision of the Court of Appeals in this case with any of the decisions of this Court. Petitioner has shown no other reason for the granting of the writ. Therefore, Respondent respectfully prays that the petition be denied.

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